REMARKS

This is a full and timely response to the outstanding final Office Action mailed November 28, 2007. Reconsideration and allowance of the application and pending claims are respectfully requested.

I.   Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-4, 8, 10, 11, 25-27, 31, 33, and 34 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Kemp, et al.* ("Kemp," U.S. Pub. No. 2002/0078160). Applicant respectfully traverses.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.,* 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Kemp reference. Applicant discusses the Kemp reference and Applicant's claims in the following.

A.   The Kemp Disclosure

Kemp discloses a system and method for printing over the Internet. As described by Kemp, the system includes a client 1, a service provider 2, and a portal 3. *Kemp,* paragraph 0035. The client 1 includes a computer workstation 10 that uses various application programs that can generate data to be printed. *Kemp,* paragraph 0036. The

service provider 2 includes a server 20 that can receive print requests and processes print jobs. *Kemp*, paragraph 0039. The portal 3 comprises a source (e.g., the sole source) of information about a plurality of service providers, including service provider 2. *Kemp*, paragraph 0042. More specifically, the portal 3 includes a database of service provider "information" that the client 1 may access. *Kemp*, paragraph 0042.

The client 1 may submit queries to the portal 3 to locate a suitable service provider. *Kemp*, paragraph 0043. Once such a service provider is located (e.g., service provider 2), the client submits a job ticket to the service provider server 20. *Kemp*, paragraph 0053. If, after reviewing the job ticket, the service provider 2 determines that it can perform the print job described in the job ticket, the service provider replies to that effect to the client 1, at which time the client may then transmit the print job to the service provider for processing. *Kemp*, paragraph 0056.

B.   Applicant's Claims

Applicant's independent claim 1 provides as follows:

1.   (Previously presented) A method of managing workflow in a commercial printing environment including a designer location and a print service provider location, said method comprising:
   creating at the designer location a digital file that represents an image to be printed;
   receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location;
   creating at the designer location relative to the received configuration information a high performance file by encapsulating a

plurality of files associated with a print job created at the designer location, the plurality of files including the digital file that represents the image to be printed and a file that includes print job processing instructions;

submitting the high performance file from the designer location to the print service provider location via an electronic network; and

performing at the print service provider location at least one of automated printing, finishing, packaging, and shipping relative to the instructions contained in the high performance file.

As an initial matter, Applicant objects to the rejections as being too vague. Specifically, the Examiner in the rejection section of the Office Action merely block copies the limitations contained in Applicant's claim 1 and, as to each of those limitations, provides a citation to "paragraph 43, 55-58, 60-62, 69-71, and 84-87" without specifically identifying the language of the Kemp reference believed to be relevant and without explanation. Although the Examiner presented a reply to Applicant's previous Response in the "Response to Arguments Section" of the Office Action, that reply provides no citations of actual teachings contained in the Kemp reference and instead generally alleges that Kemp teaches Applicant's limitations.

Applicant submits that without specific indications from the Examiner as to which particular portions of Kemp's disclosure are believed to teach the various limitations of Applicant's claims, Applicant cannot determine what the Examiner's position is and therefore cannot properly respond to the rejections. As provided in MPEP 706.07, "[t]he Examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."

In view of the above, Applicant respectfully requests that, if the Examiner wishes to maintain the rejections under Kemp, the Examiner provide greater specificity as to where Kemp teaches Applicant's individual limitations. In particular, Applicant requests that the Examiner separately identify, as to each of Applicant's limitations, what paragraph and which lines of that paragraph in which those limitations are taught.

Turning to the merits of claim 1, Applicant notes that Kemp clearly fails to teach multiple limitations of that claim. First, Kemp does not teach "receiving at the designer location from the print service provider location real time configuration information regarding a print production device at the print service provider location". Specifically, Kemp says nothing about "real time configuration information" and discloses no mechanism with which such real time configuration information is collected or shared. Although Kemp describes in paragraph 0042 that the portal 3 contains a "database of service providers," Kemp does not state that the information in the database is real time information or that the information is dynamically updated. To the contrary, it appears that the information in the database is static information that is stored in the database at the time the service provider is registered with the portal 3:

> Once a service provider has registered as a member of the service provider network, there information is added to the database maintained by portal 3.

Kemp, paragraph 0042. Applicant further notes that even if it would be possible to update the database with real time information, Kemp is silent as to such an action and therefore cannot be said to "teach" receipt of real time information either explicitly or inherently. Moreover, Applicant notes that Kemp's general reference to service

provider "information" is not a teaching of "configuration information regarding a print production device" as required by claim 1.

Turning to the next limitation of claim 1, Kemp also does not teach "creating at the designer location relative to the received configuration information a high performance file by encapsulating a plurality of files associated with a print job created at the designer location, the plurality of files including the digital file that represents the image to be printed and a file that includes print job processing instructions". Again, Kemp does not teach receiving real time configuration information. It therefore follows that Kemp does not teach creating a high performance file "relative to the received configuration information".

Perhaps even more significant, however, is the fact that nowhere does Kemp say anything whatsoever about creating a "high performance file" by "encapsulating a plurality of files . . . including the digital file that represents the image to be printed and a file that includes print job processing instructions". First, Kemp does not talk about any file that encapsulates a "plurality of files". Although Kemp speaks of "packaging" print data in paragraph 0013, Kemp is referring to packaging the print data in HTTP so that the print job can be transmitted over the Internet. *See Kemp*, paragraph 0072. Second, Kemp fails to teach a file that includes both an image to be printed and print job processing instructions. Although Kemp describes "print data" and a "job ticket," Kemp explicitly states multiple times in his disclosure that those two files are separate from each other and are provided from the client 1 to the service provider 2 separately. *See Kemp*, paragraphs 0053, 0056, 0071, and 0083. For example, Kemp states in paragraph 0053:

Upon selection of a print button in window 60 by a user, print driver rendering engine 14 performs various operations to render the print job into a format suitable for printing and for transport across the Internet to a selected service provider. As will be described in more detail below, *one operation performed by rendering engine 14 is to submit a job ticket request via Internet 5 to service provider server 20 and to receive a response to the job ticket from service provider server 20. Then, if the user confirms the job request, print driver rendering engine 14 submits the rendered print data to service provider server 20 for printing.*

Kemp, paragraph 0053 (emphasis added). As a further example, Kemp states in paragraph 0071:

While print driver 282 is waiting for a response to the job ticket from service provider server 20, the print job data remains spooled. That is, *the print job data is not submitted to service provider server 20 as part of the job ticket*, but rather, remains spooled in print driver 282. . . .

Kemp, paragraph 0071 (emphasis added). Clearly then, not only does Kemp fail to teach encapsulating an image to be printed and a file that includes print job processing instructions, Kemp actually teaches away from such an action!

In view of at least the foregoing, it is clear that Kemp does not anticipate independent claim 1, or the claims that depend therefrom. Applicant notes that although the Examiner did not explicitly indicate that independent claim 24 is believed to be anticipated by Kemp, Applicant presumes that the omission of claim 24 from the rejection was an oversight given that the Examiner rejected various claims that depend from claim

24 in view of Kemp. Applicant submits that claim 24 and its dependents are allowable over Kemp for similar reasons as claim 1 is allowable over Kemp.

II. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 6 and 29

Claims 6 and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kemp* as applied to claims 1 and 24 and further in view of *Whitmarsh* (U.S. Pub. No. 2002/0101608). Applicant respectfully traverses.

As identified above, Kemp does not teach aspects of Applicant's claims. In that Whitmarsh does not remedy the deficiencies of the Kemp reference, Applicant respectfully submits that claims 6 and 29 are allowable over the Kemp/Whitmarsh combination for at least the same reasons that claims 1 and 24 are allowable over Kemp.

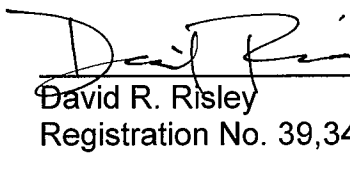### B. Rejection of Claims 5, 7, 9, 28, 30, and 32

Claims 5, 7, 9, 28, 30, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kemp*. Applicant respectfully traverses the rejection.

As identified above, Kemp does not teach aspects of Applicant's claims 1 and 24. Applicant therefore submits that claims 5, 7, 9, 28, 30, and 32 are allowable over the Kemp combination for at least the same reasons.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

David R. Risley
Registration No. 39,345